

backing, wherein the adhesive has a storage modulus at room temperature greater than  $3 \times 10^5$  Pascals and;

(c) an optical recording medium having a first major surface and a second major surface opposite the first major surface, the first major surface disposed against the layer of repositionable non-pressure sensitive adhesive.

2. (Amended) The article according to claim 1 wherein the block copolymer comprises polystyrene block.

3. (Amended) The article according to claim 2 wherein the block copolymer comprises 10% to 30% of polystyrene block.

4. (Amended) The article according to claim 1 wherein the adhesion of the repositionable non-pressure sensitive adhesive is greater than 3 oz/inch on the first major surface of the optical recording medium and is less than 3 oz/inch on skin and paper.

5. (Amended) The article according to claim 4 wherein the adhesion to the first major surface is in the range 5 - 40 ounce/inch.

6. (Amended) The article according to claim 5 wherein material forming the first major surface of the optical recording medium is selected from the group consisting of polycarbonate, polyvinyl chloride, polyester, and glass.

7. (Amended) The article according to claim 6 wherein the first major surface of the optical recording medium is a non-reading side of the optical recording medium.

8. (Amended) The article according to claim 1 wherein the backing is selected from the group consisting of polyester film, polyolefin film, paper, coated paper, metallized film, foil, non-wovens and cardstock.

10. (Amended) The article according to claim 1 wherein the adhesive has an adhesion range of 3 to 40 oz/inch when adhered to the first major surface of the optical recording medium and an adhesion of less than 8 oz/inch when adhered to standard white paper having a standard weight of 20/50 lbs.

A2

11. (Amended) The article according to claim 1 wherein the adhesion range on the first major surface is about 5 to about 10 oz/inch and the adhesion range on paper and skin is less than about 1 oz/inch.

Rule 126  
Claim 19

20. (New) The article according to claim 1 and further comprising:  
an ink receptive coating on one major surface of the backing.

A3

A version marked up to show changes made to the claim(s) relative to the previous version of the claim(s) is attached.

**Remarks**

This amendment is in response to the office action dated September 27, 2002.

Claims 1-18 (claim 18 was misnumbered as 19) were pending in the application, claims 15-18 were withdrawn from consideration, and claims 1-14 were rejected. With this amendment, claims 9 and 12-14 have been cancelled without prejudice and claims 1-8, 10 and 11 are amended. New claim 20 has been added. Pending claims 1-8, 10, 11 and 20 are in condition for allowance and reconsideration and notice to that effect is respectfully requested.

This amendment is submitted along with the following remarks to be fully responsive to the office action dated September 27, 2002. It is further submitted that this response is timely filed within the 3-month shortened statutory period. If any extension of time is necessary for this amendment to be considered timely filed, such extension is hereby requested. Please charge any additional fees due in connection with this Amendment or credit any overpayment to deposit account 13-3723. Reconsideration of all outstanding grounds of rejection and allowance of the subject application is amended is respectfully requested.

**Rejections under 35 U.S.C. § 112, paragraph 2**

Claims 2-11 and 14 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Office Action referred to “a significant number of informalisms and vague and indefinite statements.” The following rejections were specifically identified:

1) The Office Action stated that the phrase “styrene block” was not believed to be conventional terminology and a period was missing from claims 2 and 3. While Applicant contends that a person of ordinary skill in the art would understand the phrase “styrene block copolymer” as referring to a “polystyrene block copolymer”, claims 2 and 3 have been amended to clarify the invention and add a period. The scope of the claim has not been affected by this amendment.

2) The Office Action stated that in claims 4 and 5 the phrases “targeted surface” and “undesired surface” and in claim 6 the phrase “[the targeted] surfaces include but are not limited to” are vague and indefinite. Applicant respectfully submits that the 35 U.S.C. § 112, paragraph 2,

requirements of clarity and precision are met by the language of claims 4-6. The Examiner is directed to MPEP § 2173.02 which states:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In particular, due to the content of the application disclosure (see, for example, page 8, line 30 – page 9 line 2) and the use of terms which are not contrary to accepted meanings in the art, Applicant asserts that a **reasonable** level of clarity and particularity in claiming the invention is established by the use in claims 4 and 5 of the phrases “targeted surface” and “undesired surface” and in claim 6 the phrase “[the targeted] surfaces include but are not limited to”. To further increase the clarity of these claims, however, claims 4, 5 and 6 have been amended to clarify the types of surfaces indicated by the use of the words “targeted” and “undesired”. Applicant believes that this amendment does not alter the scope of the claim.

3) The Office Action stated that in claim 9, “comprises” should be “comprise”, in claim 11, “preferred” is informal, and claims 8 and 14 used improper Markush language. Claim 9 has been amended to correct the typographical error, and claims 11 and 8 were amended to address the formatting objections. None of these amendments change the scope of the claims. Claim 14 has been cancelled and the rejection is moot.

All of the rejections under 35 U.S.C. § 112 are overcome and should be withdrawn. Reconsideration and notice to that effect are respectfully requested.

**Rejection under 35 U.S.C. § 102(b) or in the alternative 35 U.S.C. § 103(a)**

Claims 1-12 were rejected as anticipated by or as obvious over either EP 443263B1 (‘263) or U.S. 5,729,963 (Bird). Claims 9 and 12 have been cancelled without prejudice and the rejection

is moot. Claim 1 has been amended to further clarify the invention. Specifically, an optical recording medium has been added as an element of the claim.

Neither the '263 reference or the Bird reference teach or suggest a backing having a coated layer of repositionable non-pressure sensitive adhesive, with a storage modulus greater than  $3 \times 10^5$ , disposed against a first major surface of an optical recording medium. As specified in MPEP 2131, "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 f.2nd 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) and also MPEP § 2143.03, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re. Wilson*, 424 f. 2nd 1382, 1385, 165 USPQ 494, 496, (CCPA 1970). Since all the elements of claim 1 are not taught or suggested alone or in combination by either the '263 reference or the Bird reference, the rejection of claim 1 is overcome and should be withdrawn. Reconsideration and notice to that effect are respectfully requested.

Claims 2-8, 10 and 11 and new claim 20 depend from newly amended and allowable independent claim 1 and are therefore themselves allowable. Applicant does not concede that the '263 reference or Bird reference disclose the additional elements of claims 2-8, 10 and 11 as was argued in the Office Action. However, due to their dependency on an allowable independent claim, any additional rejections are moot. The rejections to claims 2-8, 10 and 11 are overcome and should be withdrawn. Reconsideration, notice and allowance to that effect is respectfully requested. Consideration and allowance of new claim 20 is respectfully requested.

**Rejection under 35 U.S.C. § 103(a) by either '263 or Bird in combination with Official Notice or U.S. Patent 5,316,344**

Claims 13 and 14 were rejected under 35 U.S.C. § 103 by the '263 reference or the Bird reference in combination with Official Notice or alternatively U.S. Patent 5,316,344. Claims 13 and 14 have been cancelled without prejudice and the rejection is moot.

**Miscellaneous Amendments**

Any additional amendments to claims 1-8, 10 and 11 not specifically identified above have been made to maintain consistency of the claims or to further clarify the invention, and do not alter the scope of the invention.

**CONCLUSION**

Based on the forgoing comments it is believed that pending claims 1-8, 10, 11 and 20 are allowable over the references cited by the Examiner. Therefore, Applicant believes that pending claims 1-8, 10, 11 and 20 are in condition for allowance. Reconsideration of claims 1-8, 10 and 11, consideration of claim 20, allowance of all pending claims, and notice to that effect are respectfully requested.

The Examiner is invited to contact the undersigned at the number listed below if such a call would facilitate allowance of the application.

A DUPLICATE copy of this communication is enclosed for the "deposit". The commissioner is authorized to charge any additional fees associated with this paper or credit any overpayments to Deposit Account No.13-3723.

Registration Number 46,811	Telephone Number 651-736-6933
Date 12/12/02	

Respectfully submitted,

By

  
George W. Jonas

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, Minnesota 55133-3427  
Facsimile: (651) 736-3833  
q:\3mipc sample documents\amendment under 1-111 - version markings to show changes.doc